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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/176,639	10/20/1998	RICHARD ROBERT SCHEDIWY	028.1108	2112

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EXAMINER	
KUMAR, SRILAKSHMI K	

ART UNIT	PAPER NUMBER
2629	

NOTIFICATION DATE	DELIVERY MODE
04/30/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ifllaw.com

Office Action Summary	Application No.	Applicant(s)	
	09/176,639	SCHEDIWY ET AL.	
	Examiner	Art Unit	
	SRILAKSHMI K. KUMAR	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24 and 52-96* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24 and 52-96* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/28/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The following office action is in response to the amendment filed on February 6, 2009. Claims 24, 52-96 are pending. Claims 24, 52, 63, 68, 82 and 88 have been amended.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24, 52-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 teaches the limitation of "said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object"..."wherein the conductivity of said touch layer is configured to limit the size of said image to approximately four times the area of contact of said conductive object".

Claim 52 teaches the limitation of "wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object".

Claim 63 teaches the limitation of "wherein the conductive touch layer comprises conductive carbon disposed in epoxy and has a conductivity selected to create an image of said conductive object that is at least four times larger than an area of contact of said conductive object".

Claim 68 teaches the limitation of "wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object with said conductive touch layer".

Claim 88 teaches the limitation of "wherein said conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object".

The specification does not adequately disclose how the "conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object". In the specification on page 10, lines 4-7, applicant teaches "For best operation, the conductivity of the surface layer should be chosen such that the image of the stylus is about the same size as the image generated by a finger on a normal capacitive sensor." However, the specification does not teach how the conductivity is chosen or selected as claimed in the independent claims. The specification on page 9, lines 14-page 10, line 7, simply state that a conductivity that is too large or too small is flawed, however a moderate conductivity is appropriate. Further, the specification does not define how moderate conductivity is determined.

Therefore, the claims are indefinite since it can not be determined how the conductivity is configured to create an image of said conductive object that is larger than an area of said conductive object.

Response to Arguments

3. Applicant's arguments, see remarks, filed February 6, 2009, with respect to the rejection(s) of claim(s) 24, 52-96 under 35 USC 112, first paragraph have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of 35 USC 112, second paragraph, indefiniteness.

As shown from the rejection above, the 35 USC 112, first paragraph rejection has been withdrawn. However, a new rejection under 35 USC 112, second paragraph rejection for indefiniteness is given above.

The claims are rejected under indefiniteness, as the specification is not clear as to how the conductivity is determined, except for stating a "moderate conductivity".

With respect to applicant's arguments on page 13 of the remarks, applicant argues where by controlling the conductivity of layer 501, the image of the stylus tip can be adjusted to provide a sufficient signal on an appropriate number of electrodes. However, there is no teaching or clarity of how the conductivity of layer 501 is controlled. Applicant continually teaches in the specification of where if the conductivity is too large, the image will be very large; and if the conductivity is too small, the image will not be larger that the tip of the stylus. As previously stated, it is unclear from the claims and the specification as to how a moderate conductivity is determined and obtained.

Applicant argues on page 14 of the remarks, where the specification describes using carbon powder in epoxy as a suitable material for use in the touch layer, and where carbon powder in epoxy has inherently moderate conductivity. Examiner, respectfully, disagrees. Applicant has not provided any evidence in this regard. In the IDS, dated November 28, 2008; provided by the applicant, prior art of Niino et al (US 5,207,949) states "Highly Conductive Polyoxymethylene Resin Composition Containing Carbon Black". Niino teaches a high conductive epoxy material; thus not moderately conductive. Hijikata et al (4,772,422) is silent

with respect to the degree of conductivity of the resin. Khanna et al (US 4,436,648) teaches a thermoplastic material used in the manufacture of electret microphones. There is no teaching of it's use in a touch display, and no teaching of the degree of conductivity. In Murer et al (US 4,124,747), there is no teaching of the degree of conductivity of the polyolefin sheet element. Therefore, as discussed above, carbon powder epoxy is not shown, inherently, to have a moderate conductivity. As shown by the rejection above and the above arguments, the claims are not allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SRILAKSHMI K. KUMAR whose telephone number is (571)272-7769. The examiner can normally be reached on 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Lefkowitz can be reached on 571 272 3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Srilakshmi K Kumar/
Examiner
Art Unit 2629

SKK
April 26, 2009